IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant	: John Rozen	Art Unit	: 2153
Serial No.	: 09/757,745	Examiner	: Yasin Barqadle
Filed	: January 10, 2001	Confirmation No.: 8043	
Title	: DISTRIBUTED SELECTION OF A CONTENT SERVER		

MAIL STOP PETITIONS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

PETITION UNDER RULE 1.181

Under Rule 1.181(*a*)(1), Applicant petitions from an action of the Examiner during *ex parte* prosecution.

The specific action is a failure to grant full faith and credit to the actions of a previous examiner as required by MPEP 704.01. This action is not appealable to the Board of Patent Appeals, and is therefore petitionable.

Consistent with Rule 1.181(*c*), a request for reconsideration was made in connection with a response filed on September 7, 2006 to a final office action of August 28, 2006. This request was denied in an advisory action mailed on September 28, 2006. Applicant only decided to proceed with further prosecution shortly before filing a notice of appeal on December 27, 2006.

Rule 1.181(*f*) provides that the Director retains the option to dismiss a petition as untimely if not filed within two months of the action complained of. In this case, Applicant requests that the Director refrain from exercising that option for the following reasons. Applicant only decided to continue, rather than abandon prosecution, shortly before filing the notice of appeal. This petition is being filed promptly following the notice of appeal in an effort to avoid, if possible, an unnecessary appeal. In the interest of easing the burden on the Board of Appeals, clarifying the public record on prosecution of this application (as discussed below), and expediting prosecution, Applicant requests that this petition be considered on the merits.

STATEMENT OF THE FACTS

The relevant facts are as follows.

1. In a first office action mailed on March 1, 2004, Examiner Klinger, acting on behalf of the Patent Office:

   rejected claim 1 as anticipated by *Hasebe* under §102(*e*).

   suggested, in rejecting dependent claim 9, that claim 9's recitation of an origin server was met by *Hasebe*'s local unit **200**.

2. In a response filed on August 26, 2004, and in reliance on the Office's interpretation of *Hasebe*, Applicant amended the claim to recite the additional limitation

   "at an origin server separate from the autonomous system, receiving a request for a client for desired content."

   Applicant then asserted that *Hasebe* failed to teach this claim limitation, and drew attention to the proposed correspondence between *Hasebe* local unit **200** and the claimed origin server.

3. In a second office action, mailed on March 10, 2005, Examiner Klinger, acting on behalf of the Office:

   agreed that *Hasebe* failed to teach the newly-added limitation, and thereupon withdrew the §102(*e*) rejection; and

   rejected claim 1 as rendered obvious by the combination of *Hasebe* and *Mockapetris*, with *Mockapetris* now providing the missing limitation set forth above.

4. In responding to the second office action on September 12, 2005, Applicant presented arguments to overcome the §103 rejection.

5. In a third office action, mailed on December 15, 2005, a new examiner, Examiner Barqadle, acting on behalf of the Office:

withdrew the §103 rejection;

re-instated the §102(*e*) rejection based on *Hasebe*; and

suggested that the claimed origin server was met by the *Hasebe* exchange device **20**.

6. In responding to the third office action, Applicant drew attention to the requirement for granting full faith and credit to a previous examiner's actions and requested an explanation as to why Examiner Klinger's withdrawal of the §102(*e*) rejection was clear error.

7. Applicant filed a notice of appeal on December 27, 2006.

STATEMENT OF ACTION REQUESTED

Applicant requests that the Examiner follow the guidelines set forth in MPEP 704.01 and recently followed by the district court in *Amgen v. Hoechst Marion Roussel*, 126 F. Supp. 2d 69, 139, 57 USPQ 2d 1449, 1449-1500 (D. Mass. 2001).

According to those guidelines, the present examiner must grant full faith and credit to the actions of Examiner Klinger unless Examiner Klinger's action were clearly erroneous. Applicant therefore requests that the Examiner either:

1. Provide an explanation of why Examiner Klinger's act of withdrawing the §102(*e*) rejection was clearly erroneous; or

2. Grant full faith and credit to Examiner Klinger's actions by withdrawing the section 102 rejection based on *Hasebe*.

Applicant notes that it is particularly important in this case to clarify, for the public, the record of prosecution. Applicant has already amended claim 1 in response to a Section 102 rejection based on *Hasebe* and the Office has already withdrawn that §102 rejection in response to that amendment. Hence, it is now unclear whether that amendment should be regarded as having been necessary to overcome *Hasebe* or whether that amendment was in fact superfluous.

The answer to this question may have implications in the context of file-wrapper estoppel and the doctrine of equivalents.

A notice of appeal has been filed, with an appeal brief due on February 27, 2007. Applicant looks forward to a prompt decision to avoid, if possible, the burden of preparing an appeal brief.

No additional fees are believed to be due in connection with the filing of this petition. However, to the extent fees are due, or if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket 11125-017001.

Respectfully submitted,

Date: January 26, 2007

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